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Shlomo Shkolnik

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EXAMINER

PROCTOR, JASON SCOTT

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHLOMO SHKOLNIK

Appeal 2009-005409
Application 09/914,487
Technology Center 2100

Decided: May 26, 2010

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

Appellant has filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter “Request”) on March 15, 2010, for reconsideration of our Decision mailed January 13, 2010 (hereinafter “Decision”) with respect to claims 72 and 92 (Request 1).

The Decision affirmed the Examiner’s rejections of claims 23-26, 30, 31, 41, 42, 51, 72-76, and 80-92 under 35 U.S.C. § 103(a) as being unpatentable over Thackston in view of Carver (Decision 16). Our affirmance of the rejection of claims 23-26, 30, 31, 41, 42, 51, 73-76, and 80-91 is not the subject of this Request (Request 1-3).

We have reconsidered our Decision of January 13, 2010 regarding claims 72 and 92, in light of Appellant’s comments in the Request, and we find Appellant has not identified any points misapprehended or overlooked by the Board in our Decision therein. We decline to change our Decision for the reasons discussed *infra*.

II. ISSUE

The issue we address on this Request is whether Appellant has identified any points misapprehended or overlooked by the Board in our holding claims 72 and 92 unpatentable over Thackston in view of Carver.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellant's Brief

1. As to claim 72, Appellant contends that “the entire concept of Thackston is that information on all parts should be stored” (App. Br. 16), and thus, “[w]hile applicant agrees with the Examiner that not all information is accessible by all designers, it is a primary principle in Thackston that all information be stored in the system, since all of the information is used by at least some designers, so all the information must be present in the database” (*id.*).
2. As to claim 92, Appellant contends that “the claims further requires that the system includes a second database that associates each of the worker codes with one or more workers responsible for design, such that changing worker assignments does not require changes in the part numbers” (App. Br. 19) and contends that “[n]o such second database is taught or suggested by Thackston” (*id.*).

IV. PRINCIPLES OF LAW

“[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in . . . the principal brief[]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee.” *Kaufman Company v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986). “Considering an argument advanced for the first time in a reply brief . . . is not only unfair to

an appellee but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered.” *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986) (internal citations omitted). “The failure to raise all issues and arguments diligently, in a timely fashion, has consequences.” *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision).

V. ANALYSIS

In the Request, Appellant contends that, in our Decision, “there were a number of errors, misapprehensions or overlooking of arguments made in the brief” (Request 1). In particular, Appellant contends that “regarding claim 72, the Board overlooked an important set of limitations that were argued in the reply brief starting at page 13 fourth full paragraph to page 14, third full paragraph” (Request 2; emphasis added). Appellant similarly contends that, regarding claim 92, “Thackston is completely silent in regard to any identification of workers responsibilities for design” wherein “[t]his argument was made in the first three full paragraphs on page 17 of the reply brief” (Request 2; emphasis added).

Regarding claim 72, although Appellant contends that “the Board overlooked an important set of limitations that were argued in the reply brief” (Request 2), such contention was not raised in the Appeal Brief (FF 1). It is inappropriate for Appellant to discuss for the first time in the Reply Brief matters that could have been raised in the Appeal Brief. *See Kaufman Company*, 807 F.2d at 973 and *McBride*, 800 F.2d at 1211.

As set forth in our Decision, we address Appellant's contention set forth in Appellant's Appeal [Principal] Brief and, in agreeing with the Examiner, hold that "[o]ne of ordinary skill in the art would have found it obvious that a particular stored part design model may comprise less than 10% of all elements" as required by claim 72 (Decision 12-13). As set forth in the Decision, contrary to Appellant's contention set forth in Appellant's Appeal Brief, "claim 72 does not preclude storing of all elements but rather merely requires that fewer than 10% is selected" (Decision 12).

Similarly, regarding claim 92, although Appellant contends that arguments were made in Appellant's Reply Brief (Request 2), such contention also was not raised in the Appeal Brief (FF 2). As set forth in our Decision, we addressed Appellant's contentions as set forth in the Appeal Brief and agreed with the Examiner that "associating worker codes with one or more workers responsible for the design", as required by claim 92, "reads on Thackston's 'stored design and analysis access permission data module 860'" (Decision 13).

Thus, Appellant has not identified any points misapprehended or overlooked by the Board in our Decision holding that the Examiner did not err in rejecting claims 72 and 92 over the applied prior art.

Accordingly, Appellant's Request does not persuade us of any points we misapprehended or overlooked in our Decision and to reverse the Examiner's rejection of claims 72 and 92. Therefore, we find Appellant's arguments unavailing.

VI. CONCLUSION

We have carefully considered the arguments raised by Appellant in the Request for Rehearing, but find no points misapprehended or overlooked by the Board in our Decision and none of these arguments are persuasive that our original Decision was in error. We are still of the view that the invention set forth in claims 72 and 92 is unpatentable over the applied prior art based on the record before us in the original appeal. This Decision on Appellant's Request for Rehearing is deemed to incorporate our earlier Decision (mailed January 13, 2010) by reference. *See* 37 C.F.R. § 41.52(a)(1).

VII. DECISION

We have granted Appellant's request to the extent that we have reconsidered our Decision of January 13, 2010, but we deny the request with respect to making any changes therein.

REHEARING DENIED

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